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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,572	12/26/2001	Lee Codel Lawson Tarbotton	01.134.01	8371

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Zilka-Kotab, PC  
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EXAMINER
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ZIA, SYED

ART UNIT	PAPER NUMBER
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2131

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/12/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/025,572	TARBOTTON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Syed Zia	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-10,13-18 and 21-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5, 8-10,13, 16-18, 21, 24, 25 and 28 is/are rejected.
- 7) ☒ Claim(s) 6,7,14,15,22,23,26 and 27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This office action is in response to amendment, and argument filed on November 27, 2006. Original application contained Claims 1-24. Applicant previously amended Claims 1, 9, 17, 18, 21, 23-24, added new Claims 25-28, and cancelled Claims 3-4, 11-12, and 19-20. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. Presently pending claims are 1-2, 5-10, 13-18, 21-28.

#### ***Response to Arguments***

Applicant's arguments filed on November 27, 2006 have been fully considered but they are moot because of new ground of rejection.

#### ***Allowable Subject Matter***

Claims 6-7, 14-15, 22-23, and 26-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and subject to overcoming the following rejections.

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-2, 5-8, 17-18, and 21-28 are rejected under 35 U.S.C. 101 because they are not statutory.

2. As per claims 1-2, 5-8, and 25-28, all that is claimed is a “computer program product” which is merely software code which is not tangible. Applicant is reminded that for computer software to be tangible it must be embodied on a computer recordable medium. See MPEP 2106. Correction is required.

3. As per claims 17-18, and 21-24 the invention is an apparatus, however all that is claimed is different types of “logic”, which is merely software code and is not tangible. Applicant is reminded that for computer software to be tangible it must be embodied on a computer recordable medium. See MPEP 2106. Correction is required.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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2. Claims 1-27 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 1, 9, and 17 recite the term "more thorough option" in claims 1, 9, and 17 is a relative term which renders the claim indefinite. The term "more through option" is not further defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention.

Claim 28 recites the limitation "the computer system", and "the user" in line 1-2. There is insufficient antecedent basis for this limitation in the claim. Applicant decided to direct examiner attention to "associated computer system" defined in claim 1, but it is not clear how this "the computer system" (claim 28), and "a computer" (claim 1 line 1), and "an associated computer system" (claim 1 line 16) are related and which "computer system" this "the computer system" (claim 28) is referring to

The Examiner assert that the term "at least substantially" in claim 1, 9, and 17 is a relative term which renders the claim indefinite. The term "at least substantially " is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 8, 9, 16, 17, 24, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cozza [US Patent 5,502,815] in view of Chess et al. [US Patent 6,772,346], Hurska [Virus Detection], and Ellenberger [US Patent 5,684,875].

Cozza teaches a virus scanning method where the file state information is stored in a cache that can be referenced on subsequent scans to increase performance. Specifically, Cozza teaches a computer program product for controlling a computer to scan computer files for malware [Abstract], said computer program product comprising:

- Malware scanning code operable to malware scan all computer files stored within a storage location [Fig. 3 22] as addressed by an operating system [inherent in definition of volume] to identify any computer files stored within said storage location that contain malware [Col. 3 lines 34-36]
- Identification code operable if no computer files containing malware are found in said storage location [Fig. 4 58 “no”] to identify said storage location as a clean storage location [Fig. 4 62]

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- When subsequently reading a computer file determination code operable to determine whether or not said computer file is stored within a clean storage location [Fig. 4 40] and:
  - If said computer file is not stored within a clean storage location, then malware scanning said computer file [Fig. 4 40 “no”->42->44]

What is not taught is that if said computer file is stored within a clean storage location, then permitting reading of said computer file without further malware scanning the scanning is done as a background task, or that the malware scanning of clean locations is done using more through scanning options.

Chess et al. teach an antivirus system where files are sent to a central location for scanning in a distributed system. A specific scanning method is also taught in Fig. 3, wherein no scanning is done in two particular cases – the file is known to be non-malicious [Fig. 3 320] or the file contains no or minimal code [Fig. 3 330]. In addition, Cozza et al. teach that “at the present time there are no such viruses that affect the resource forks of files on Apple Macintosh computer without changing the resource forks of files ... without changing the resource fork length, so no scanning would be necessary in step (50)” [Col. 4 lines 41-46]. It is also well known in the art that the resource fork does not exist on 68K Mac executables.

It would have been obvious to one of ordinary skill in the art, that if the system the invention of Cozza et al. was running on was a 68K Mac and the file was known to be non-malicious or contained minimal code and was in the data cache, to not scan the file. Cozza et al. teach that the subset of viruses, which do not effect cached data, should be scanned. Cozza et al. additional teach that in 68K Macs this scan for resource forks is unnecessary. As for data fork

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scanning, Cozza et al. remain silent on the specifics of what a scan entails. Chess et al. teach a particular scanning method, which provides “rigorous analysis, including ... execution on a simulated environment, ... specifically-instrumented machines..., static analysis and other methods...” [Col. 6 lines 45-55]. One of skill in the art would wish to use a scanner that uses rigorous analysis, and thus it would be obvious to use this scanner as the scanner in the system of Cozza et al, which in some cases does not scan.

The combination of Cozza et al. and Chess et al. still does not teach malware scanning the scanning is done as a background task, or that the malware scanning of clean locations is done using more thorough scanning options.

Hruska gives an overview of virus detection methods. In regards to On-Access scanning it is taught that it is “much safer then any alternative” [Pg. 129 Col. 2 “On-access virus scanning”]. It is also taught that on-access scanning “intercepts file open and file close operations,” [Pg. 129 Col. 2 “On-access virus scanning”] hence it is a background task.

It would have been obvious to one of ordinary skill in the art to apply the methods of Cozza et al. to an on-access scanner. On-access scanners were well known in the art, and Hruska teaches that it is much safer then any alternative for virus interception. This scanning would then be performed as a background task.

What is still not taught is that the malware scanning of all computer files stored within a storage location as a background task that occurs as a function of when an associated computer system is at least substantially idle and is performed with more thorough scanning options selected than for on-access scanning applied to computer files not stored within clean storage locations and being accessed by a user.



Ellenberger teaches a virus scanning method where one or more virus detection algorithms are selected at random for each scan. Specifically, the invention selects “some detection algorithms of the fast group and some of the thorough, but slow executing group” when choosing algorithms.

It would have been obvious to use the methods of Ellenberger to select the specific virus detection algorithms used when scanning as the algorithm used by the combined invention of Cozza et al. Ellenberger teaches that using all algorithms would be too slow, and the method taught “surpasses current state of the art without undue consumption of resources” [Col. 8 lines 51-54]. Since some scanners will inherently be more or less thorough than others depending on the criteria chosen to measure thoroughness [See 112 rejection – ‘more thorough’ being a relative term] in some cases the scanning done for a referenced secure location will have more thorough scanning options than a default location.

6. In regards to claim 9, what is claimed is a method that corresponds to the actions of the computer program product claimed in claim 1. The same rationale of rejection applies.

7. In regards to claim 17, what is claimed is an apparatus for scanning computer files for malware, the apparatus containing logic operable to perform the same operations as the computer program product of claim 1. The invention of Cozza et al. is specifically identified as a “method and apparatus for detecting the existence of a computer virus on a computer.” [Col. 1 lines 6-7]

8. In regards to claims 8, 16, and 24 the invention of Cozza et al. is specifically drawn to anti-virus scanning.

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9. In regards to claim 28, as claimed in claim 1, wherein the background task avoids interference with a responsiveness of the computer system when the user starts to use the computer system Ellenberger [Col. 8 lines 51-54].

10. Claims 2, 10, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cozza et al. as applied to claims 1, 9, and 17 above, and further in view of Colorado et al. [How to Exclude Folders from NAV Virus Scanning?].

Cozza et al. teach all the limitations of claims 1, 9, and 17. What Cozza et al. do not teach is that said malware scanning of all computer files stored within a storage location is performed upon a set of user specified storage locations from within all storage locations accessible to a user.

Colorado et al. teach that in Norton Antivirus that it is possible to exclude folders from scanning for on-access and on-demand scanning [Reply by John Robson, Wed Apr 4 2001 3:40pm] and that it is desirable to do so in some cases for performance reasons [Reply by Colorado Dave, Wed Apr 4 2001 6:35pm].

It would have been obvious to one of ordinary skill in the art to modify Cozza et al. to exclude certain folders from scanning. Colorado et al. teach that doing so would be beneficial in certain cases since certain high-activity and low-risk folders would unnecessarily increases the system load due to constant on-access scanning. In regards to claim language, the “user specified storage locations from within all storage locations” would be the set of all storage locations, minus the specified excluded storage locations.

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11. Claims 5, 13, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cozza et al. as applied to claims 1, 9, and 17 above, and further in view of Symantec.com [Norton Antivirus 2001 for Windows 2000/NT/Me/98/95].

Cozza et al. teach all the limitations of claims 1, 9, and 17 above. What Cozza et al. do not explicitly teach is that a compute file is malware scanned before being written to a clean storage location.

Symantec.com teaches that their virus scanner “scans files you download from the web, as well as attachments you get through email.” [Paragraph 1, lines 5-7]

It would have been obvious to one of ordinary skill in the art to scan files being written to any storage location. This was common practice in the art at the time in order to attempt to catch certain classes of viruses at the point of infection, and Symantec.com specifically teaches this feature.

12. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cozza et al. as applied to claim 1 above, and further in view of Faltstrom et al. (RFC 1740: MIME Encapsulation of Macintosh Files – MacMIME).

Cozza et al. teach all the limitations of claims 1. What Cozza et al. do not explicitly teach is that if the file is stored within said clean storage location, then said computer file is permitted to be read without further time spent on malware-related processing.

Faltstrom et al. teach in relation to the sending of Macintosh files that “Documents which lack a data fork must be sent as AppleSingle” [Pg. 3 2c Paragraph 2]

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It would have been obvious to one of ordinary skill in the art, if files were being scanned that do not include a data fork, that no further malware scanning would take place. As referenced in claim 1 Cozza et al. already teach that given a clean storage location resource forks are not scanned. If a data fork is not present, then the data fork scanning cannot proceed and thus no further malware scanning is done.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Zia whose telephone number is 571-272-3798. The examiner can normally be reached on 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SZ  
February 27, 2007

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02/27/2007